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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,231	08/08/2001	Ruth E. Rosenholtz	110268	9878

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OLIFF & BERRIDGE, PLC.
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

TRAN, QUOC A

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/682,231	Applicant(s) ROSENHOLTZ ET AL.	
	Examiner Tran A. Quoc	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 1, 3, 6 & 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to Amendment filed 09/18/2006, with acknowledgement of original filing date of 08/08/2001.
2. Claims 1-8 are currently pending in this application. Claim 1 and 6 are independent claims.

Response to Arguments

3. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objection

4. Regarding claims 1, 3, 6, and 8, the phrase "more" and "substantially" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. The Examiner is uncertain of the applicant intention "more" and "substantially. It is unclear what Applicant's intended the metes and bounds of the claims are, thereby rendering the scope of the claim(s) unascertainable.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or

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claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 16, 20-21 and 38 of U.S. Patent No. 7,069,506 (hereinafter '506). Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the independent claims in '506 contains part of the independent claims 1, 6 and dependent claims 2-5, 7-8 in the application.

As an example claim one of the application contains,

"1. (Currently Amended) A computer-executable method of displaying a document associated with a thumbnail generated based on an original document, comprising: displaying the thumbnail corresponding to an original document and including an enhancement in appearance as displayed on the thumbnail; receiving a request to display the original document; displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of the at least a portion of the first version to the corresponding portion of the original document and the corresponding portion of the thumbnail."

Comparing to some of the text in the claims 1, 4, 16, 20-21 and 38 of patent '506,

"1. (Currently Amended) A method for generating an enhanced thumbnail associated with a document, comprising: obtaining a document comprising a plurality of elements; generating a reduced-size representation of the document; and modifying an appearance of at least one visible element of the plurality of elements relative to other visible elements of the plurality of elements in the reduced-size representation, wherein modifying the appearance of the at least one visible element comprises automatically overlaying an overlay element on or near the reduced-size representation in association with the at least one visible element based on importance of the at least one visible element, the overlay element comprising one or more of an enlarged version of the visible element, a zoom of the visible element, a callout visibly connected with the visible element, a blurry text version of the visible element, and a perspective text version of the visible element."

Wherein patent '506 (claims 1, 4, 16, 20-21 and 38) is obvious over, or anticipated by the broadening claims 1-8 of the applicant claimed invention, but not changing the features of the invention. For example a thumbnail of a document is a reduced-size representation of the

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document and a method of enhancing a reduced-size representation of the document is the same as a method of enhanced thumbnail associated with a document.

“A later patent claim is not patentable distinct from an earlier patent claim if the later claim is obvious over, or anticipated by, the earlier claim. In re Longi, 729 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus).” ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohrabough et al US 20020091738A1, CIP of 09/828,511 filed 07/07/2001, non-provisional of provisional 60/211,0169 filed 06/12/2000 (hereinafter Rohrabough).

9. **In regard to independent claim 1, displaying the thumbnail corresponding to an original document** (see Rohrabough at page 6, paragraph 68) discloses a method and apparatus

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for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image thumbnails to the client before SVF (Simple Vector Format) stream is available.

displaying a first version of the original document, (see Rohrabough at page 6, paragraph 68) discloses a method and apparatus for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image thumbnails to the client before SVF (Simple Vector Format) stream is available.

Rohrabough does not explicitly teach, **and including an enhancement in appearance as display on the thumbnail, receiving a request to display the original document**. However, (see Rohrabough at page 6, paragraph 68) discloses a method and apparatus for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image thumbnails to the client before SVF (Simple Vector Format) stream is available, and also (see Rohrabough at page 1, paragraph 10) discloses a method and apparatus for supporting resolution independent vector wherein the vector format enables the client to substantially retain an original page layout within a set of layouts originally intended to be associated with the requested Web content by including page layout information in a vector database. Finally, the vector-formatted Web content is provided to the client. Also (see Rohrabough at the abstract), discloses apparatus and methods for creating resolution-independent vector display of Internet content to allow it to be scaled (zoomed) larger and smaller for better viewing or to fit any resolution or screen size. It is notes that the above reasonably reads enhancement in appearance as display on the thumbnail as claimed.

at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than to a corresponding portion of the original document. However (see Rohrabauh at page 6, paragraph 68) discloses a method and apparatus for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image thumbnails to the client before SVF (Simple Vector Format) stream is available, also see (see Rohrabauh at page 11, paragraph 0101, also see Fig 7A-B and 9A-B) discloses scaling and offsetting content directly by the client user-interface software for PDA's, which provides additional functionality. For instance, a user may select to view a column (results represented in FIG. 7B by tapping that column with a stylus, as shown in FIG. 7A. Similarly, the user may select to zoom in on an image by tapping the image with the stylus, as shown in FIGS. 8A and 8B, or select to view a paragraph in an article by tapping on the paragraph, as shown in FIGS. 9A and 9B.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Rohrabauh's resolution independent vector (i.e. SVG Simple Vector Format) to allow document to be independently scaled (i.e. zoom) larger and smaller at only a portion of the display screen will actually be used to display content, to including an enhancement in appearance as display on the thumbnail, receiving a request to display the original document and at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than to a corresponding portion of the original document. One of ordinary skill in the art would have been motivated to perform such a modification to provide user the improved visual ability for reading small text or hard to see small images for displaying if internet content

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on small ratio devices, such as cell phones and hand help computers (see Rohrabough page 1 paragraph [0008]).

In regard to independent claim 6, incorporate substantially similar subject matter as cited in claim 1 above, further view of the following, and is similarly rejected along the same rationale,

A display device and a controller, (see Rohrabough at page 11, paragraph 0101, also see Fig 7A-B and 9A-B) discloses scaling and offsetting content directly by the client user-interface software for PDA's, which provides additional functionality. For instance, a user may select to view a column (results represented in FIG. 7B by tapping that column with a stylus, a shown in FIG. 7A. Similarly, the user may select to zoom in on an image by tapping the image with the stylus, as shown in FIGS. 8A and 8B, or select to view a paragraph in an article by tapping on the paragraph, as shown in FIGS. 9A and 9B.

In regard to dependent claim 2, displaying a second version of the original document in which a portion corresponding to the at least a portion of the first version is more similar to the corresponding portion of the original document, However (see Rohrabough at page 6, paragraph 68) discloses a method and apparatus for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image thumbnails to the client before SVF (Simple Vector Format) stream is available, also see (see Rohrabough at page 11, paragraph 0101, also see Fig 7A-B and 9A-B) discloses scaling and offsetting content directly by the client user-interface software for PDA's, which provides additional functionality. For instance, a user may select to view a column (results represented in FIG. 7B by tapping that column with a stylus, a shown in FIG. 7A. Similarly, the user may select

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to zoom in on an image by tapping the image with the stylus, as shown in FIGS. 8A and 8B, or select to view a paragraph in an article by tapping on the paragraph, as shown in FIGS. 9A and 9B.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Rohrbaugh's resolution independent vector (i.e. SVG Simple Vector Format) to allow document to be independently scaled (i.e. zoom) larger and smaller at only a portion of the display screen will actually be used to display content, to displaying a second version of the original document in which a portion corresponding to the at least a portion of the first version is more similar to the corresponding portion of the original document. One of ordinary skill in the art would have been motivated to perform such a modification to provide user the improved visual ability for reading small text or hard to see small images for displaying if internet content on small ratio devices, such as cell phones and hand help computers (see Rohrbaugh page 1 paragraph [0008]).

In regard to dependent claim 3, wherein the second version is substantially identical to the original document, (see Rohrbaugh at page 6, paragraph 68) discloses a method and apparatus for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image thumbnails to the client before SVF (Simple Vector Format) stream is available. It is noted thumbnail is a reduced version of the original document.

In regard to dependent claim 4, wherein the corresponding portion of the thumbnail comprises an element modified during generation of the thumbnail, However (see Rohrbaugh at page 6, paragraph 68) discloses a method and apparatus for supporting resolution independent vector wherein the HTTP carrier over TCP that allows a server to push image

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thumbnails to the client before SVF (Simple Vector Format) stream is available, also see (see Rohrabough at page 11, paragraph 0101, also see Fig 7A-B and 9A-B) discloses scaling and offsetting content directly by the client user-interface software for PDA's, which provides additional functionality. For instance, a user may select to view a column (results represented in FIG. 7B by tapping that column with a stylus, a shown in FIG. 7A. Similarly, the user may select to zoom in on an image by tapping the image with the stylus, as shown in FIGS. 8A and 8B, or select to view a paragraph in an article by tapping on the paragraph, as shown in FIGS. 9A and 9B.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Rohrabough's resolution independent vector (i.e. SVG Simple Vector Format) to allow document to be independently scaled (i.e. zoom) larger and smaller at only a portion of the display screen will actually be used to display content, wherein the corresponding portion of the thumbnail comprises an element modified during generation of the thumbnail. One of ordinary skill in the art would have been motivated to perform such a modification to provide user the improved visual ability for reading small text or hard to see small images for displaying if internet content on small ratio devices, such as cell phones and hand help computers (see Rohrabough page 1 paragraph [0008]).

In regard to dependent claim 5, is directed to a storage medium for performing the method of claim 1, and is similarly rejected along the same rationale.

In regard to dependent claims 7-8, incorporate substantially similar subject matter as cited in claims 2-3 and 6 above, and are similarly rejected along the same rationale,

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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran A. Quoc whose telephone number is 571-272-8664. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R. Heather can be reached on (571) -272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A, Tran
Patent Examiner
Technology Center 2176
November 21, 2006


Heather R. Herndon
Supervisory Patent Examiner
Technology Center 2100